

Interview Summary

Application No.

10/777,772

Applicant(s)

FUKUNAGA ET AL.

Examiner

Darwin P. Erez

Art Unit

3731

All participants (applicant, applicant's representative, PTO personnel):

(1) Darwin P. Erez.

(3) _____.

(2) Dr. Schein.

(4) _____.

Date of Interview: 29 May 2007.

Type: a) ☒ Telephonic b) ☐ Video Conference

c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☐ No.

If Yes, brief description: _____.

Claim(s) discussed: 1.

Identification of prior art discussed: 7,178,521 to Burrows.

Agreement with respect to the claims f) ☒ was reached. g) ☐ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: See Continuation Sheet.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN A NON-EXTENDABLE PERIOD OF THE LONGER OF ONE MONTH OR THIRTY DAYS FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

Examiner's signature, if required

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: The Examiner and Dr. Schein discussed the availability of US 7,178,521 as a prior art. The '521 patent has a prior date of 1/9/04. Dr. Schein provided information regarding the subject matter of the parent cases for the instant application. See attached e-mail. The abstract for 6,874,500 (parent case) states that the outer flexible conduit may be pleated to provide non-rebounding axial extension and contraction. Col. 8 , line 64 to col. 9, line 8 also cites the axial extension or contraction of the unilimb circuit. As such, the subject matter of a pleated tubing having non-rebounding characteristics has a priority date back to the filing of the '500 patent, which is 9/24/02.

Erezo, Darwin

From: Shinelegal@aol.com
Sent: Wednesday, May 30, 2007 10:21 AM
To: Erezo, Darwin
Cc: ab.fukunaga@verizon.net
Subject: Re: Pat Appln SN 10/777,772

Dear Examiner Erezo:

Thank you very much.

Respectfully submitted,

Daniel B. Schein, Ph.D., Esq.
 Attorney for applicants

In a message dated 5/30/2007 7:05:44 A.M. Pacific Daylight Time, Darwin.Erezo@USPTO.GOV writes:

Dr. Schein,

Thank you for your response. I will review the information you provided below. If adequate to overcome the Kings patent, I will send out the Notice of Allowance. If not, I will send out a NF rejection and will email you a courtesy copy. Unfortunately, it has to be done this way because our email conversations are not part of the record right now. I would prefer to have it in writing to have a complete prosecution history.

Darwin Erezo

Patent Examiner AU 3731
571-272-4695

-----Original Message-----

From: Shinelegal@aol.com [mailto:Shinelegal@aol.com]
Sent: Tuesday, May 29, 2007 3:25 PM
To: Erezo, Darwin
Subject: Re: Pat Appln SN 10/777,772

Copy attached of US Patent 6,874,500, which issued from priority application 10/254,700, filed 24 September 2002.

In a message dated 5/29/2007 12:11:16 P.M. Pacific Daylight Time, Shinelegal writes:

Dear Examiner Erezo:

Thank you very much for informing us of your concern regarding US Patent 7,178,521, which has a priority date of 9 January 2004. This gives us an opportunity to promptly address your concern and expedite prosecution of both application 10/777,772 and application 10/942,230. Published application 2005/0150505 A1 corresponds to the application that issued as US Patent 7,178,521, and is reference # 79 in the IDS for 10/942,230 and reference # 82 in the IDS for 10/777,772.

Application 10/777,772 is a CIP of 10/390,070, filed 14 March 2003, which is a CIP of US Patent Application 10/254,700, filed 24 September 2002 (which in turn claims priority of earlier filed provisional applications).

5/30/07

US Patent 6,874,500 (copy attached), issued from US Patent Application 10/254,700, filed 24 September 2002. Exemplary portions of US Patent 6,874,500 are listed below that support the current claims of 10/777,772.

Since co-pending application 10/942,230 is a continuation of 10/254,700, to the extent there are similar or identical claim limitations in both applications the portions of US Patent 6,874,500 that issued from 10/254,700 and referred to in support of the claims in 10/777,772 can also be relied upon to support the claims of 10/942,230.

Following is exemplary support for the claims of 10/777,772 and 10/942,230 found in US Patent 6,874,500 (which issued from application 10/254,700, filed 24 September 2002); this also supports withdrawal of rejection(s) based upon US Patent 7,178,521:

(1) A breathing circuit comprising two pleated tubes is illustrated in Figures 7A and 7B of US Pat. 6,874,500.

(2) The corresponding description of Figures 7A and 7B is found in the specification of US Pat. 6,874,500, for example at:

column 11, lines 4-6;
column 13, line 57 to column 14, line 4.

Pleated tubing is also referred to as "accordion-like" tubing in US Patent 6,874,500, which issued from 10/254,700. Further examples of support for the claimed circuits of the present inventions are found in US Patent 6,874,500 at:

column 4, line 66 to column 6, line 3 (compliance),
column 5, lines 4-17 (spontaneous and assisted ventilation),
column 8, line 64 to column 9, line 8 (interaction of the two tubes with axial extension or contraction), and
column 9, lines 16-21 (alternative embodiment of circuit with pleated walls in two lumens).

It is respectfully noted that US Patent 7,178,521 is directed to pleated tube circuits, such as those described in the above-referenced sections of US Patent 6,874,500 (i.e., 10/254,700). In fact, Paragraph 006 of US Patent 7,178,521 refers to the published application of 10/390,070, which is the parent application of 10/777,772 and paragraph 007 refers to the published application of 10/254,700.

Should the Examiner require anything further to withdraw the rejection based upon US Patent 7,178,521, please telephone or send an email to the undersigned so that prosecution may be expedited.

Respectfully submitted,

Daniel B. Schein, Ph.D., Esq.
For Applicants

Daniel B. Schein, Ph.D., Esq., Inc.*

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shinelegal@aol.com

In a message dated 5/29/2007 7:22:22 A.M. Pacific Daylight Time,
Darwin.Erezo@USPTO.GOV writes:

Dr. Schein.

I updated the search for this application prior to filling out the notice of allowance. However, I came across a new patent, 7,178,521, which is assigned to Kings system. I checked the '772 case and there is no assignee listed. The '521 patent has an earlier filing date for the pleaded limitation. A non-final rejection will be mailed out shortly.

Darwin Erezo

Patent Examiner AU 3731

571-272-4695

-----Original Message-----

From: Shinelegal@aol.com [mailto:Shinelegal@aol.com]

Sent: Tuesday, May 22, 2007 2:55 PM

To: Erezo, Darwin

Cc: ab.fukunaga@verizon.net

Subject: Pat Appln SN 10/777,772

US Patent Application Serial No.: 10/777,772

Filing Date: February 12, 2004

Title: BREATHING CIRCUITS HAVING
UNCONVENTIONAL RESPIRATORY CONDUITS AND
SYSTEMS AND METHODS FOR OPTIMIZING
UTILIZATION OF FRESH GASES

Inventors: Atsuo, Blanca & Alex Fukunaga

Dear Examiner Erezo:

Thank you very much for your assistance in examining of the related applications of Atsuo, Blanca & Alex Fukunaga. We wish to expedite prosecution as much as possible, and in this regard, attached is a copy of an improper disapproval of the Terminal Disclaimer filed May 14, 2007 in this case. The basis for the disapproval is that "[o]nly two of the three inventors are listed as owners." As you can see from the attached copy of the Terminal Disclaimer downloaded from the PAIR system, (1) Atsuo, (2) Blanca & (3) Alex Fukunaga are all named. I would be grateful if you could forward this to the paralegal specialist that issued the Disapproval, Jan Hurley, in Technology Center 3700, or otherwise advised me of the most expedient manner of approving of the Terminal Disclaimer.

Respectfully submitted,

Daniel B. Schein, Ph.D., Esq.
For Applicants

Daniel B. Schein, Ph.D., Esq., Inc.*

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